

REMARKS

Claims 1-28 are pending in the present application and stand rejected. No amendments to the Claims 1-28 as originally filed have been submitted herein.

In the Office Action mailed on July 17, 2007, Claims 1-2, 4-9, 14, 20-21, 25 and 27 are rejected under 35 USC § 103(a) as being unpatentable over US Pat. No. 5,567,860 B1 to Maxwell et al. (hereinafter referred to as “Maxwell”) in view of Santoro et al. (20030020671 A1 hereinafter referred to as “Santoro”) and further in view of US Pat. No. 6,681,323 to Fontanesi et al. (hereinafter referred to as “Fontanesi”). Claims 3, 21 and 26 are rejected under 35 USC § 103(a) as being unpatentable over Maxwell as modified by Fontanesi as applied to Claim 2 and further in view of US Pat. No. 6,832,379 to Zeryck et al. (hereinafter referred to as “Zeryck”). Claims 10-13 are rejected under 35 USC § 103(a) as being unpatentable over Maxwell in view of Santoro and further in view of Fontanesi as applied in Claim 5 and further in view of US Pat. No. 6,098,097 to Dean et al. (hereinafter referred to as “Dean”). Claims 15-19, 24 and 29 are rejected under 35 USC § 103(a) as being unpatentable over Maxwell in view of Santoro and further in view of Fontanesi as applied in Claim 14 and further in view of US Pat. No. 6,934,956 to Allen (“Allen”).

Applicants respectfully traverse the foregoing rejections based on the following remarks.

Claims 1-2, 4-9, 14, 20-21, 25 and 27

To establish a *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Applicants respectfully submit that the combination of Maxwell, Santoro and Fontanesi fails to teach or suggest all of the limitations recited in independent Claims 1, 20 and 25.

As a basis for the foregoing rejection, it is asserted in the above-referenced Office Action that:

“Maxwell discloses a method of displaying a vendor provided information screen in response to a log-in experience, said method comprising: providing a screen driver to the OS during the installation (6:5-30); displaying the information screen (6:5-30).”

Applicants respectfully disagree with both of the above cited assertions. The add-device tool of Maxwell is a utility that, under control of a user, facilitates a process of updating/modifying an existing and installed OS through the addition of new device drivers that do not already exist in the installed version of the OS. This is typically necessitated by the addition of new hardware devices that have been added to the system since the time of its original configuration. The add-device tool of Maxwell is designed to generate code by which an OS that has already been installed can be modified with one or more new drivers, but not to provide a driver during the installation of the OS. Indeed, the only discussion of a driver within the cited text is in conjunction with an error log maintained by the tool while it is generating code modifications so that a user can see why the tool might fail to complete its task of adding drivers to the already installed OS at the behest of the user. The drivers provided by invocation and use of the add-device tool could never occur during installation of the OS; a system simply cannot run a utility such as the add-device tool of Maxwell prior to or during installation of the OS.

Moreover, while it may be fair to assume that a device driver of some kind is included in the OS that is capable of facilitating the displaying of the GUI of the add-device tool of Maxwell

when it is finally invoked sometime after the log-in experience, there is no teaching or suggestion by Maxwell that such a driver is provided to the OS **while the OS is being installed**. Even if this driver were so provided, there is no teaching or suggestion that this driver could or would be executed in response to the initiation of the log-in experience. Indeed, it is conceded in the above-referenced Office Action that "*Maxwell does not expressly disclose executing the screen driver upon initiation of the log-in experience.*" Of course, the reason that Maxwell does not teach this element, either expressly or impliedly, is that Maxwell does intend for this utility to be invoked automatically during execution of a log-in experience. As previously pointed out, the add-device tool of Maxwell is a utility that is consciously invoked by a user, either directly or under control of another program invoked by the user.

In contrast to Maxwell, the claimed invention provides a screen driver to the OS **during the installation of the OS**. This causes the screen driver to be automatically executed during the log-in experience by the system and essentially alters the normal log-in process thereby. More specifically, execution of the driver causes the display of a screen during the log-in process, the purpose of which is to alert the user to the existence of upgrades to the OS which should be installed before proceeding to other tasks upon completion of the log-in process. All of this is accomplished without any knowledge of the user and with no direct intervention by the user save the user's unwitting initiation of the log-in experience.

With respect to the assertion that Maxwell discloses the recited limitation displaying the information screen, Applicants respectfully submit that this limitation is only met by Maxwell if taken in isolation, which is legally impermissible when determining the patentability of a claim. The Claims must be read as a whole, rather than element by element. *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983). When viewed as part of the rejected Claims as a whole, it is clear that

the displaying limitation is a sub-element of the executing the screen driver upon initiation of the log-in experience claim element. Put another way, the displaying function is performed as part of the executing function. As such, Maxwell does not teach or suggest that the GUI screen of the add-device tool is ever performed as a part of a process of executing the screen driver upon initiation of the log-in experience.

In summary of the foregoing, nowhere in Maxwell is it taught or even suggested that the add-device tool is or can be invoked to display its GUI by providing a screen driver during installation of the operating system, and then executing the screen driver upon initiation of the log-in experience, which includes or leads to displaying the information screen. Given the difference in functional purpose of the add-device tool of Maxwell compared to that of the present invention, this lack of disclosure is not surprising. Nor are these limitations taught or even suggested in any of the other cited references. The failure of the cited references to teach any one of the above-underlined limitations of Claims 1, 20 and 25 is sufficient to refute a *prima facie* case of obviousness which is required legally establish such a rejection. When all of the missing limitations are taken in combination, it is respectfully submitted that the rejection of Claims 1, 20 and 25 as being obvious over the cited references is even more clearly traversed.

While the foregoing remarks are alone legally sufficient to demonstrate that a *prima facie* case of obviousness has not been established, thereby traversing the rejection of Claims 1, 20 and 25, Applicants will address other recited limitations of the independent Claims that are not taught or suggested in within the four corners of any of the cited references. In the above-referenced Office Action, it is further conceded that:

“Maxwell does not disclose executing the screen driver upon initiation of the log-in experience, said executing the screen driver further comprising:

maintaining visibility of the information screen over subsequently generated display

screens until occurrence of a predetermined event; and

completing the log-in experience.

Notwithstanding it is asserted that Santoro discloses:

“...permits a user to specify or alter operating parameters of applications programs running on the system, though at any given time a particular application program will take priority, meaning that a particular window will be displaying continually updating content... [0063],”

Based on the foregoing citation from Santoro, the Examiner concludes that “[t]herefore, it would have been obvious ... to combine Maxwell and Santoro because, it would enable continually updating the window with the most priority as suggested by Santoro.”

Applicants respectfully assert that the foregoing basis for supporting the rejection Claims 1, 20 and 25 is flawed on a number of levels. First, even assuming that Santoro does in fact suggest or teach the maintaining limitation as suggested above, the combination of references must teach or suggest all of the limitations of the Claims to establish a *prima facie* case of obviousness. As previously set forth above, none of the references, including Santoro teach the providing or displaying limitations.

Second, the maintaining limitation cannot be viewed in isolation of the rest of the Claim, but must be viewed in conjunction with the Claim as a whole. Viewing the rejected Claims as a whole, the maintaining limitation is recited as a sub-process of the executing the screen driver upon initiation of the log-in experience claim element. Put another way, the maintaining function is performed as part of the executing function. Again, even if it is assumed *arguendo* that Santoro

does teach or suggest the maintaining limitation, there is no teaching or suggestion within Santoro (as is the case with Maxwell or any of the other cited references) that such a maintaining function be performed as part of an overarching process of executing the screen driver upon initiation of the log-in experience. Indeed, the GUI of Santoro is an application that is configured by a user after the user is already logged in and thus would not even contemplate how it could be modified for implementation in the middle of the log-in process.

Third, Applicants respectfully point out that Santoro does not teach or suggest the maintaining function as recited in Claims 1, 20 and 25. Santoro discloses a technique by which a GUI can be created consisting of tiles each representing one of several applications running on a system simultaneously. The tiles are dimensionally small and consist of a fraction of the information contained in the display screen or window maintained by each of the applications. The purpose of the invention taught by Santoro is to provide the user with a GUI that displays a tile representing each of a plurality of applications running on the system. These tiles are not screens or windows, but rather small snippets of the total data that would otherwise be displayed on the full individual screens generated by those applications. The user can decide, at any time, which of the screens to view in full by clicking on a particular tile, which will only then prioritize the display of the full screen represented by the selected tile.

It is also important to note that the priority referred to in the quote from Santoro above is NOT referring to the **display priority** of the screen of one application over another, but rather the priority by which each of the screens associated with these applications receives updated data. This priority is completely unrelated to maintaining the visibility of one screen over another. The only way display priority is affected in Santoro is when a user knowingly selects one screen of one application for display over another. Thus, combining the GUI taught by Santoro with the add-

device tool of Maxwell would lead to a tile as part of the Santoro GUI that would consist of a small portion of the information comprising the GUI screen of the Maxwell add-device tool. This tile would be displayed along with tiles representing numerous other applications. The tile of the Santoro GUI could not provide the information required to be conveyed by the “information screen” of the claimed invention, nor would it solve the problem of maintaining the display priority of the “information screen” over subsequently generated screens during a log-in process to ensure that a user see it without having to consciously select it.

Based on the foregoing, it is respectfully submitted that neither the teachings of Maxwell nor Santoro, nor the teachings of any of the other cited references teach or suggest the limitations maintaining visibility of the information screen over subsequently generated display screens until occurrence of a predetermined event, which is performed as part of a process of executing the screen driver upon initiation of the log-in experience, as recited in the rejected independent Claims. Moreover, their combined teachings do not and can not achieve the present invention as claimed. This alone is sufficient to demonstrate that a *prima facie* case of obviousness has not been established to support the rejection of independent Claims 1, 20 and 25. When taken in combination with all of the other limitations that Applicants have clearly demonstrated as not being taught or suggested by the cited art, it is respectfully submitted that the rejection of Claims 1, 20 and 25 as being obvious over the cited references is even more clearly traversed.

With respect to the recited limitations of Claims 1, 20 and 25 concerning the initiation and completion of an OS, Applicants respectfully point out that it is legally impermissible to view these limitations in isolation. These limitations are further modified in the rejected Claims by the limitation providing a screen driver during installation of the operating system, which occurs in between the initiation of the installation and the completion of the installation, the provided screen

driver being the one executed upon initiation of the log-in experience. Fontanesi discloses a method and system for automatically installing an initial configuration onto a computer (1:63-65), which includes the initiating and completing of an installation of an OS. However, there is no teaching that a screen driver be provided to the OS during that installation, that the provided screen driver be executed upon initiation of a log-in experience to display an information screen, that visibility of the information screen be maintained contrary to the default paradigm of displaying the most recently generated screen above those previously generated screens, that such visibility be maintained until occurrence of a predetermined event, and that the log-in experience be completed. Further, while the add-device tool of Maxwell is designed to generate code for purposes of modifying the already installed version of the OS, this is provided to the OS prior to its re-installation, not during.

With respect to currently pending dependent Claims 2, 4-9, 14, 21 and 27, Applicants respectfully point out that if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Because Claims 2, 4-9, 14, 21 and 27 depend from one of the independent Claims 1, 20 or 25, in view of the foregoing remarks successfully traversing the rejection of Claims 1, 20 and 25, the rejection of Claims 2, 4-9, 14, 21 and 27 under 35 USC § 103(a) based on the combination of Maxwell and Fontanesi is also traversed.

Claims 3, 21 and 26

With respect to currently pending dependent Claims 3, 21 and 26, Applicants respectfully point out that if an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Because Claims 3, 21 and 26 depend from independent Claims 1, 20 and 25 respectively, in view of

the foregoing remarks successfully traversing the rejection of independent Claims 1, 20 and 25, the rejection of Claims 3, 21 and 26 under 35 USC § 103(a) based on the combination of Maxwell, Fontanesi and Zeryck is also traversed.

Claims 10-13

With respect to currently pending dependent Claims 10-13, Applicants respectfully point out that if an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Because Claims 10-13 depend from independent Claim 1, in view of the foregoing remarks successfully traversing the rejection of independent Claim 1, the rejection of Claims 10-13 under 35 USC §103(a) based on the combination of Maxwell, Fontanesi and Dean is also traversed.

Claims 15-19, 24 and 29

With respect to currently pending dependent Claims 15-19, 24 and 29, Applicants respectfully point out that if an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Because Claims 15-19, 24 and 29 depend from one of the independent Claims 1, 20 or 25, based on the foregoing remarks successfully traversing the rejection of independent Claims 1, 20 and 25, the rejection of Claims 15-19, 24 and 29 under 35 USC § 103(a) based on the combination of Maxwell, Fontanesi and Allen is also traversed.

In summary, the cited references fail to teach numerous recitations of Claims 1, 20 and 25 as set forth in detail above. Moreover, those few limitations that can be demonstrated as being taught by these references can be done so only when taken in isolation of the Claims as a whole, which is legally impermissible when determining patentability as set forth in numerous cases

including the one cited above. The absence of any one of the limitations recited in Claims 1, 20 and 25 in the teachings of the cited references is sufficient to demonstrate a failure to establish a *prima facie* case of obviousness for purposes of rejecting those Claims. Thus, Applicants respectfully submit that the rejection of Claims 1, 20 and 25 for being obvious over the cited references is clearly traversed. While Applicants could demonstrate that numerous additional limitations, as recited in the Claims that depend from Claims 1, 20 and 25, are also not taught or suggested by the cited references, Applicants respectfully point out that there is no need to address them absent the establishment of a legally sufficient *prima facie* case of obviousness with respect to independent Claims 1, 20 and 25.

CONCLUSION

In view of the remarks set forth above, Applicants respectfully request allowance of the pending claims as originally filed. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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Date: October 8, 2007

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